

Appl. No. : 09/927,851
Filed : August 10, 2001

REMARKS

Claims 1-35 were pending in this application. The Examiner rejected Claims 1-35. By this amendment, Applicant has amended Claims 1, 19, and 32-35, canceled Claims 26-31, and added new Claims 36-39. As a result, Claims 1-25 and 32-39 are now pending. Reconsideration of the application, as amended, is respectfully requested.

Rejections under 35 U.S.C. § 112

The Examiner rejected Claims 1-18, 19-25, and 32-35 under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, the Examiner stated that it was unclear how hardcopies were incorporated in the system. In response to these rejections, Applicant has amended Claims 1, 19, and 32-35 to clarify how the hardcopy documents are incorporated in the systems and methods recited in the claims. These claim amendments are not believed to narrow the scope of the claims.

Support for the amendments can be found in the paragraph beginning at page 7, line 28 of the specification. In view of these amendments, Applicant respectfully requests the Examiner to withdraw the rejection of Claims 1-18, 19-25, and 32-35 under 35 U.S.C. § 112, second paragraph.

Rejections under 35 U.S.C. § 103

Claims 1-23, 26-29, and 32-35

The Examiner rejected Claims 1-23, 26-29, and 32-35 under 35 U.S.C. § 103(a) as being unpatentable over Lenk et al. (U.S. Patent No. 6,366,923) in view of Cassorla et al. (U.S. Patent No. 5,146,552). By this amendment, Claims 1, 19, and 32-35 have been amended such that the systems and methods recited in these claims each include a database having hardcopy document records in which a description of the physical location of one or more hardcopy documents is stored.

The Examiner asserts that Cassorla discloses storing a location of a hardcopy document in a hardcopy document record in a database. However, Cassorla does not disclose, teach or suggest storing a *description of the physical location* of a hardcopy document in a database, as required by the amended claims. Moreover, Lenk does not cure the deficiencies of Cassorla because, as the Examiner has acknowledged, Lenk does not disclose, teach or suggest a database having this feature.

Appl. No. : 09/927,851
Filed : August 10, 2001

Accordingly, Claims 1, 19, and 32-35 are not obvious in view of Lenk and Cassorla, and Applicant respectfully requests allowance of these claims.

In addition, Claims 2-18 and 20-23, which depend from Claims 1 and 19, respectively, are patentably distinguished from Lenk and Cassorla for the same reasons stated above with respect to Claims 1 and 19, and because of the additional features recited therein. Therefore, Applicant respectfully requests allowance of Claims 2-18 and 20-23.

Claims 24-25 and 30-31

The Examiner rejected Claims 24-25 and 30-31 under 35 U.S.C. § 103(a) as being unpatentable over Lenk in view of Cassorla and Salas et al. (U.S. Patent No. 6,233,600). As discussed above, Lenk and Cassorla do not disclose teach or suggest storing a *description of the physical location* of a hardcopy document in a database, as required by amended Claim 19, from which Claims 24-25 depend. Salas does not cure the deficiencies of Lenk and Cassorla because Salas does not disclose, teach or suggest a database having this feature. Accordingly Claims 24-25 are patentably distinguished from Lenk, Cassorla, and Salas for the same reasons stated above with respect to Claim 19, and because of the additional features recited therein. Therefore, Applicant respectfully requests allowance of Claims 24-25.

NEW CLAIMS

New Claims 36-37 depend from amended Claim 1 and are believed to be allowable for the same reasons articulated above with respect to Claim 1, and because of the additional features recited therein. In addition, new Claims 38-39, which depend from amended Claim 19, are believed to be allowable for the same reasons articulated above with respect to Claim 19, and because of the additional features recited therein.

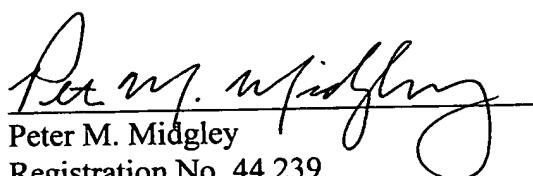
Appl. No. : 09/927,851
Filed : August 10, 2001

CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully submits that Claims 1-25 and 32-39 are in condition for allowance and notification to that effect is earnestly requested. If the Examiner has any questions or concerns regarding this application, please contact the undersigned at (208) 433-9121.

Respectfully submitted,

Dated: 11 / 17 / 03

By: 
Peter M. Midgley
Registration No. 44,239
Attorney of Record
Customer No. 39,510

Attorney for Applicant
Midgley Patent Services
P.O. Box 170440
Boise, ID 83717-0440
T – (208) 433-9121
F – (208) 433-8989

H:\DOCS\PMMPMM-2816.DOC:sam
061003